

Appl. No. 10/083,050  
Atty. Docket No. 8439M  
Reply. Dated November 14, 2003  
Reply to Office Action of August. 14, 2003  
Customer No. 27752

### ELECTION/RESTRICTION

The Office Action states that the present application contains three distinct inventions. More specifically, the Office Action alleges that these three inventions are:

- I. Claims 1-12, drawn to a pre-moistened wipe classified in class 442, subclass 59+;
- II. Claims 16 and 17, drawn to a method for improving the hand feel of a pre-moistened wet wipe classified in class 427, sub class various; and
- III. Claims 13 to 15 and 18 to 20, drawn to a dispensing article of classified in class, 221 subclass various.

### APPLICANTS' RESTRICTION WITH TRAVERSE

In order to make a restriction in compliance with the M.P.E.P., Applicants restrict the present application to the first group, that is Claims 1-12. This is a confirmation of the provisional election with traverse made by Assignee's Attorney on August 4, 2003.

Applicants respectfully traverse this restriction requirement. Applicants submit that the Examiner has not satisfied various requirements in the M.P.E.P. in rendering the restriction requirement. M.P.E.P. §808 provides that:

Every requirement to restrict has two aspects, (1) the reasons (as distinguished from the mere statement of conclusion) why the inventions as claimed are either independent or distinct, and (2) the reasons for insisting upon restriction therebetween as set forth in the following sections. (Emphasis in original.)

Applicants submit that, the Examiner has failed to provide a requisite basis for the Restriction Requirement per Part (1) of M.P.E.P. §808. Instead, the Examiner's comments regarding the restriction are merely conclusory. Furthermore, contrary to Part (2) of M.P.E.P. §808, the Examiner has provided insufficient reasons, as described in other sections of the M.P.E.P., for insisting upon restriction.

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In any event, since the claims of group I and III are similar in subject matter, technology and application, there would be no significant burden placed on the Examiner to search and examine these two groups together.

Furthermore, Applicants respectfully disagree with the characterization of the invention of Groups I and II. The invention of Group II is directed to a method of "improving the softness and feel and/or reducing the tackiness of a premoistened wipe" and not just a method of making the invention of Group I.

For all of the above reasons, Applicants hereby traverse the Restriction Requirement since the restriction in this instance is improper and the Examiner failed to provide the proper analysis detailed explanation in the Restriction Requirement mandated by the rules and the searching and examining all of the claims at issue would present no significant burden on Examiner. For all of the above reasons, the Restriction Requirement is improper and should be withdrawn.

Consequently, Applicants have restricted, with traverse, the present application to the set of claims identified in the Office Action as Group I, that is the claims directed to the premoistened wipe. The claims in this group are Claims 1-12. Because the Office Action has not satisfied the burden of demonstrating that restriction is proper, Applicants request reconsideration of the election of species requirement.

### OBJECTIONS

#### (1) Abstract

The Office Action has objected to the Abstract of the invention. Specifically, that the abstracts format does not comply with what is desired under M.P.E.P. § 608.01(b). Applicants are revising the entire contents of the Abstract and have included a revised abstract on a separate sheet as requested in the Office Action.

#### (2) Claim 8

Claim 8 has been objected to because of the misspelling of the term propylene. Claim 8 has been amended to correct this misspelling.

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### REJECTIONS

#### Rejections Under 35 U.S.C. §102

##### Bissett

Claims 1-4, 6-9 and 11 have been rejected under 35 U.S.C. §102(b) as being anticipated by Bissett et al., US Patent No 5,821,237. It is the Examiner's contention that the claimed premoistened wipes are anticipated by the disclosure of Eckhouse. Applicants respectively traverse the rejection.

Section 2131 of the MPEP states to anticipate a claim, the reference "MUST TEACH EVERY ELEMENT OF THE CLAIM" (emphasis in original). Applicants respectfully submit that all the claim limitations are not taught or suggested by Eckhouse, as shown below.

Applicants submit that Bissett does not teach every element of Applicants' amended Claim 1. Applicants' claimed invention requires that the nonwoven substrate be either an airlaid nonwoven substrate or a hydroentangled nonwoven substrate. This element at least is missing from Bissett. Consequently, Claim 1 and the claims dependent therefrom, i.e. Claims 2-4, 6-9 and 11, are not anticipated by Bissett.

In view of the foregoing remarks and the clarifying amendments, it is respectfully requested that rejection of Claim 1-4, 6-9 and 11 be reconsidered and withdrawn.

#### Rejection under 35 U.S.C. 103

##### 1) Bissett in view of Luu

Claims 4 and 10 are rejected under 35 U.S.C. §103 as being obvious over Bissett, US Patent No 5,821,237 in view of Luu et al., US Patent No. 5,871,763. It is asserted in the Office Action that the claimed premoistened wipes are obvious in light of what is taught by Bissett in view of Luu. Applicants respectively traverse the rejection.

It is well known that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of

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ordinary skill in the art, to modify the reference or to combine reference teachings. In re Rouffet 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir.1998). Second, there must be a reasonable expectation of success. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See MPEP 2143.01; In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); and In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. MPEP706.02(j); In re Vacck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); and MPEP Section 2143 - Section 2143.03.

Turning to the present rejection, it is clear that the Office Action has failed to establish a prima facie case of obviousness. Neither Bissett nor Luu has any teaching of a nonwoven substrate which is either an airlaid nonwoven substrate or a hydroentangled nonwoven substrate.

Furthermore, it is apparent that the rejection is applying the "obvious to try" standard which has been consistently held improper. It is well settled that the question of obviousness under 35 U.S.C. §103 is not what the artisan could have done, but rather what would have been obvious for such a person to do. See Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 1 U.S.P.Q.2d 1081 (Fed. Cir. 1986), and In re Brouwer, 37 U.S.P.Q.2d 1663 (Fed. Cir. 1996). See also MPEP 2143.01; In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). It is unclear as to why one of ordinary skill would consider the combination of Bissett and Luu relevant. Furthermore, there is no teaching, motivation and/or suggestion to one of ordinary skill modify any possible combination of Bissett and Luu.

Consequently, in view of the foregoing remarks and the clarifying amendments, it is respectfully requested that the rejection of Claims 4 and 10, be reconsidered and withdrawn.

2) Bissett

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Claim 12 is rejected under 35 U.S.C. §103 as being obvious over Bissett, US Patent No 5,821,237. It is asserted in the Office Action that the claimed method is obvious in light of what is taught by Bissett. Applicants respectively traverse the rejection.

Turning to the present rejection, it is clear that the Office Action has failed to establish a prima facie case of obviousness. Bissett has no teaching or suggestion of a nonwoven substrate which is either an airlaid nonwoven substrate or a hydroentangled nonwoven substrate.

Consequently, in view of the foregoing remarks and the clarifying amendments, it is respectfully requested that the rejection of Claim 12, be reconsidered and withdrawn.

#### ALLOWABLE SUBJECT MATTER

In the instant Office Action, Claim 5 is never specifically rejected, nor is objected to as being allowable but dependent upon a rejected Claim, i.e. Claim 1. Assignee's Attorney is unsure if this means that Claim 5 is allowable as filed or if was meant to be rejected in some form. Clarification as to the status of Claim 5 is respectfully requested.

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CONCLUSION

In light of the amendments and remarks presented herein, Applicants respectively submit that Claims 1-12 are allowable over the prior art of record or any combination thereof. In the event that issue remain prior to allowance of the noted claims, then the Examiner is invited to call Applicant's undersigned agent to discuss any remaining issues.

Respectfully submitted,

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